

Remarks

Claims 2-40 and 42-59 are pending in the Application. Claims 1 and 41 have been canceled. Three independent claims (2, 58, and 59) are pending. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

The Indicted Allowable Subject Matter

Claims 6-39 and 42-57 were indicated allowable if written in an independent form. The indication of allowable subject matter is greatly appreciated. Claim 6 has been written in an independent format as new claim 58. Claim 42 has been written in an independent format as new claim 59.

The Claim Objections

Claims 45-52 were objected to because of a typographical error in claim 45. The Examiner's notice of the typographical error is appreciated. The typographical error has been removed. Therefore, it is respectfully requested that the objections be withdrawn.

The Claim Rejections

Claim 41 was rejected as being anticipated pursuant to 35 U.S.C. § 102(e) by Andersen (US 2003/0057271).

Claims 1-5 and 40 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Andersen in view of Lee (US 6,824,049).

Claims 1 and 41 have been canceled. Thus, claim 2 stands as the only independent claim currently rejected.

Claim 2

The Action (on page 3) admits that Andersen does not teach or suggest an ATM having both a magnetic stripe reader and a RFID reader, especially where both readers are positioned adjacent to the same card slot.

The Action alleges that Lee's "radio frequency card recognition unit [253] is operative to read data from a radio frequency card inserted into the slot" (magnetic card slot 252a). The Action further alleges that it would have been obvious to employ Andersen with "a machine having both a magnetic stripe reader and a RFID reader" and "to position the RFID reader adjacent to the magnetic stripe reader and the slot so that the user can easily locate the RFID reader". The Applicant respectfully disagrees. The applied prior art is devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce the recited invention.

Claim 2 recites that "the tag reader is operative to read data from a card RFID tag inserted in the slot". Andersen and Lee, taken alone or in combination, do not teach or suggest an automated banking machine with the ability to read both magnetic stripe data and RFID tag data from the same card slot.

Lee does not teach or suggest (as alleged) reading the radio-frequency card in the magnetic card slot (252a). Conversely, as discussed in more detail herein, Lee teaches against the features attributed thereto.

First, Lee explicitly teaches using the magnetic card slot (252a) for receiving magnetic stripe cards or IC cards (col. 6, lines 59-60). That is, the slot is used for cards that need to be located in the machine to permit their reading. There isn't any teaching or suggestion in Lee of

inserting a radio-frequency card in the magnetic card slot (252a). Nor would one having ordinary skill in the art do so, especially in light of Lee's explicit teaching.

Second, Lee explicitly teaches using the "card fluoroscopy window 253a for reading the radio-frequency card" (col. 6, lines 57-58) as it is passed near the window (col. 5, lines 45-46). Lee specifically uses the fluoroscopy window (253a) (not the magnetic card slot 252a) for reading a radio-frequency card. That is, Lee teaches that the radio-frequency card is read outside of the machine.

Third, Lee teaches that reading of the radio-frequency card is limited to a short distance (col. 5, lines 37-38). This teaches against the fluoroscopy window (253a) being able to read a card distantly located in the magnetic card slot (252a).

Fourth, the outward facing arrangement of Lee's fluoroscopy window (253a) (Figure 5) teaches against reading a radio-frequency card in the magnetic card slot (252a). It is well known in arrangements such as Lee's to have the user pass the face of their radio-frequency card in a direction parallel to the face of the fluoroscopy window (253a) to permit reading of the card. However, the face of a card inserted in the magnetic card slot (252a) would be perpendicular to (not parallel to) the face of the window (253a). Again, Lee teaches against reading a radio-frequency card in the magnetic card slot (252a).

Fifth, Lee teaches using separate cards (i.e., magnetic stripe card, radio-frequency card, and IC card) for separate use with the respective separate readers (252, 253, 254). That is, Lee teaches against using a single card with plural readers.

Sixth, the Action's allegation to insert a radio frequency card into a magnetic card slot goes against Lee's advantage of using radio-frequency cards, i.e., avoiding the need to insert the card into a slot. Andersen (like Lee) also teaches advantageously reading a radio-frequency card

"without having to physically accept the ATM card" (paragraph 38). That is, Anderson teaches against the very reason for modification thereof.

The Action is silent as to how Andersen could be structurally modified with the teaching of Lee to have produced the recited invention, especially when Lee doesn't teach or suggest the features attributed thereto by the Office and Andersen teaches against the alleged modification. Lee can't alleviate the admitted and noted deficiencies in Andersen.

The attempt to modify Andersen is based solely on impermissible hindsight reconstruction of Appellant's claimed invention. It would not have been obvious to one having ordinary skill in the art to have modified Andersen as alleged to have produced the recited apparatus. The record lacks substantial evidence support for the rejection. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Action does not factually support any *prima facie* conclusion of obviousness. Even if it were somehow possible (which it isn't) to modify Andersen with the teaching of Lee as alleged, the result still would not teach or suggest the recited apparatus.

For reasons of brevity the Applicant has not necessarily presented all the reasons as to why the applied references do not render claim 2 obvious. Applicant reserves the right to later present even more reasons. Nevertheless, Applicant's arguments show that the applied references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. Hence, Applicant's claim 2 patentably distinguishes over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Conclusion

Applicant respectfully submits that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000